

REMARKS

Claims 1-22, 25-47 and 56 are pending in this application.

The examiner rejects all pending claims.

Claim 29 is canceled without prejudice.

No amendments have been made to the remaining pending claims which are 1-22, 25-28, 30-47 and 56 remain pending.

For the reasons presented below, Applicant believes that the pending claims are allowable over the cited prior art references.

In support of the Applicant's position, Applicant hereby submits a Rule 1.132 declaration ("Declaration") of the inventor, Alain Yang. The substance of the Declaration is discussed below in reference to the claim rejections.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-22, 25-47 and 56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over a single prior art documented reference, WO 01/31131 to Zeng ("Zeng"). For the reasons provided below, this rejection is traversed.

The independent claims 1 and 22 require "scrap inorganic fibers containing phenol/formaldehyde binder thereon"

The examiner states that although Zeng's suggestion for the use of scrap fibers in his product does not include the use of scrap fibers that contain phenol/formaldehyde binder thereon the scrap fibers as required by the pending claims, a person having ordinary skill in the art would have found it obvious to use scrap inorganic fibers from virtually any source including fibers that were treated with the binder to improve their toughness at the time of their manufacture and having a variety of diameters. This rejection is legally insufficient to satisfy the examiner's initial burden of establishing *prima facie* obviousness.

To establish a *prima facie* case of obviousness, the following three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings; (2) there must be a reasonable expectation of success; **and** (3) the prior art reference must teach or suggest all the claim limitations. MPEP § 2142; see also, MPEP § 2143.03; *In re Vaeck*, 947 F.2d 488, 492 (Fed. Cir. 1991); *In re Royka*, 490 F.2d 981 (CCPA 1974)). The examiner has not met any of the three requirements for establishing *prima facie* case of obviousness.

First, the examiner has not made a proper showing of proper motivation to modify the teachings of Zeng. The examiner must show reasons that one of ordinary skill in the art, with no knowledge of the claimed invention, would select the elements from the prior art for combination in the manner recited in the claims. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000); *In re Rouffet*, 149 F.3d 1355, 1359 (Fed. Cir. 1998) (citing *Environmental Designs v. Union Oil*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983)). Here, Zeng does not make any reference to a need for the examiner's purported motivation to improve, to improve the fibers toughness and have a variety of diameters. In fact, Zeng teaches quite the opposite. Zeng states on page 2, lines 8 to 13, that the residual cured phenol-formaldehyde binder material found in conventional insulation product is not desired for the acoustical insulation product disclosed in Zeng because of the lumps/beads formed by such binder. As a solution to the problem, Zeng discloses a product that uses multi-component polymer fibers as the binder rather than a resin binder. (See Zeng's Summary Of The Invention at page 4). Thus, Zeng's disclosure teaches away from using scrap fibers "containing phenol/formaldehyde binder thereon" as required by the claimed invention because of the lumps/beads of cured phenol-formaldehyde binder material are present in such scrap fibers. Accordingly, one of ordinary skill in the art looking at the Zeng disclosure would not be motivated to modify the teachings of the disclosure to make the claimed invention.

Secondly, the examiner has not shown a reasonable expectation of success with the modification of the prior art teachings suggested by the examiner. "The teaching or suggestion to make the claimed combination **and the reasonable expectation of success must both be found in the prior art**, not in applicant's disclosure." MPEP § 2143 (emphasis added) (citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)). As discussed above, Zeng's disclosure states that it would not be desirable to use scrap glass fibers "containing phenol/formaldehyde binder thereon" the fibers as required by the claimed invention. Other than the statement that it would be obvious to do so, the examiner has not provided any evidence in the prior art that would suggest that there is a reasonable expectation that such modification would be successful.

Lastly, as noted by the examiner, not all of the claimed limitation is taught or suggested by Zeng, the only prior art reference cited. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *See also*, MPEP § 2143.03). Namely, Zeng does not disclose the claim limitation “scrap inorganic fibers containing phenol/formaldehyde binder thereon.” (Office Action at page 3). Thus, the examiner’s statement that it would have been obvious for one of ordinary skill in the art to modify the teachings of Zeng and use such scrap fibers **not disclosed in the cited prior art** is legally incorrect, even if the examiner’s assertion that the motivation to modify the deficient disclosure of Zeng can be properly found in the prior art. The examiner’s argument is legally incorrect because the examiner is relying on hindsight based on the claimed invention to provide the element missing in the Zeng reference.

Therefore, because the examiner has not made a proper showing of *prima facie* case of obviousness, the rejection of claims 1-22, 25-47 and 56 under 35 U.S.C. § 103(a) over Zeng should be withdrawn. Reconsideration and allowance are requested of the claims 1-22, 25-47 and 56.

Furthermore, according to the Declaration of Alain Yang submitted herewith, the use of such scrap inorganic fibers containing phenol/formaldehyde binder thereon resulted in a beneficial result of a product with more loft and enhanced overall fiber matrix structural integrity compared to products made from rotary glass fibers that do not have any such binder material thereon.

According to the Declaration, this benefit is attributed to the preset glass fiber matrix and the additional glass fiber to glass fiber bonding provided by the presence of the phenol/formaldehyde binder material on the scrap fibers. These benefits would be unexpected or unknown to someone like Zeng, since he chose to replace the phenol-formaldehyde resin binder with polymer fiber binders in his product because residual cured phenol-formaldehyde binder is not desirable in his product. Therefore, the use of the scrap inorganic fiber containing phenol/formaldehyde binder thereon, which is not disclosed in the cited prior art of record, Zeng, is patentably distinguishable from the prior art of record.

CONCLUSION

Applicants believe that the pending claims are allowable over the cited prior art reference. Reconsideration and allowance are requested of the pending claims. Should the examiner disagree

with the Applicant's position, a telephone interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

Respectfully submitted,

Date: February 22, 2007

/Won Joon Kouh/

Reg. No. 42,763
An Attorney for Applicant
(609) 631-2435

PTO Customer No. 08933
DUANE MORRIS LLP